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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,255	11/08/2000	Brett T. Hannigan	P0243	3458

23735 7590 07/27/2005

DIGIMARC CORPORATION
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EXAMINER

RADA, ALEX P

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Set

Office Action Summary

Application No.

09/709,255

Applicant(s)

HANNIGAN ET AL.

Examiner

Alex P. Rada

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4-6 and 20-22 is/are allowed.
- 6) ☒ Claim(s) 8 and 10-14 is/are rejected.
- 7) ☒ Claim(s) 15-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/9/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to the amendment filed May 9, 2005 in which the applicant cancels claims 3, 7, and 9, amends claims 1-2, 4, 8, and 10-11, and claims 1-2,4-6, 8, and 10-22 are pending in this office action.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Wellner (US 5,640,193).
3. Wellner discloses the following:

Decoding machine-readable information conveyed with a printed publication and performing an action based on the information, wherein the action is linking to an interactive multiplayer game related to the publication or its subject matter (col. 2, lines 29-42 and figure 2).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (5,89,700) in view of Rifkin et al. (US 6,065,969).

6. Williams et al disclose decoding machine-readable information conveyed with a printed publication and performing an action based on the information (summary).

Williams et al does not expressly disclose the action is retrieving artwork from a data store and printing the artwork for coloring by a child.

Rifkin et al teaches the retrieving artwork from a data store, in which the examiner interprets the CD-ROM to be equivalent to the data store and printing the artwork for coloring by a child, in which the examiner interprets the game of customizing the nail coverings and then printing the designs to be an equivalent to printing the artwork for coloring by a child. By retrieving artwork from a data store and coloring and printing of the design, one of ordinary skill in the art would provide a virtually endless amusing activity for fashion and entertainment.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Williams et al to include retrieving artwork from a data store and printing the artwork for coloring by a child as taught by Rifkin et al to provide a virtually endless amusing activity for fashion and entertainment.

7. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wellner (US 5,640,193) in view of La Tour (US 5,888,070) and Linebarger (US 6,068,485).

8. Wellner discloses the following:

Decoding machine-readable information conveyed with a printed publication
and performing an action based on the information as recited in claim 11.

Wellner does not expressly disclose the following:

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The associated action is speech and the speech incorporates both text from the book and substitute words as recited in claim 11.

Retrieving the substitute words from a local store as recited in claim 12.

Soliciting words from a child, recording the child's words, and using the recorded word as the substitute words as recited in claim 13.

The substitute words customize the book text to a particular child or locale as recited in claim 14.

La Tour teaches the following:

The associated action is speech and the speech incorporates both text from the printed publication and substitute words, in which the examiner interprets the recording of parts of the text (word) to be equivalent and capable of incorporating text from the book and substitute words (summary) as recited in claim 11.

Soliciting words from a child, recording the child's words, and using the recorded word as the substitute words, in which the examiner interprets the recording of parts of the text (word) being equivalent and capable of incorporating text from the book and substitute words (summary) as recited in claim 13.

The substitute words customize the book text to a particular child or locale, in which the examiner interprets the multipart drama to be an equivalent to the customizing of the textbook (summary) as recited in claim 14.

Linebarger teaches the following:

Retrieving the substitute words from a local store, in which the examiner interprets the memory (12) to be an equivalent to the words from a local store as recited in claim 12. By incorporating substituted, recorded, and stored local words,

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one of ordinary skill in the art would provide a learning aid to enhance a child's interest in reading.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Rhoads to further include the action of the associated action is speech and the speech incorporates both text from the book and substitute words, retrieving the substitute words from a local store, soliciting words from a child, recording the child's words, and using the recorded word as the substitute words, and the substitute words customize the book text to a particular child or locale as taught by La Tour and Linebarger to enhance a child's interest in reading.

Allowable Subject Matter

9. Claims 15-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 1-2, 4-6, and 20-22 are allowed.

11. The following is a statement of reasons for the indication of allowable subject matter: The prior art does disclose nor teach an image sensor for sensing steganographic watermark encoded data in combination with the rest of the claimed limitations.

Response to Arguments

12. Applicant's arguments with respect to claims 1-6, 8, and 10-22 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex P. Rada whose telephone number is 571-272-4452. The examiner can normally be reached on Monday - Friday, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Jessica Harrison can be reached on 571-272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APR



JESSICA HARRISON
PRIMARY EXAMINER